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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,467	11/19/2003	Luliang Jiang	59864.01178	3763
32294 7590 09/12/2008 SQUIRE, SANDERS & DEMPSEY L.L.P. 8000 TOWERS CRESCENT DRIVE 14TH FLOOR VIENNA, VA 22182-6212				
EXAMINER				
SAEED, USMAAN				
ART UNIT		PAPER NUMBER		
2166				
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09/12/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/715,467

Applicant(s)

JIANG, LULIANG

Examiner

USMAAN SAEED

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/16/2008 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. A computer program, embodied on a computer readable medium in claim 20 is not described in the specification.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 20 is rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. The language of the claims raises a question as to whether the claims are directed merely to an environment or machine which would result in a practical application producing a concrete useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

This claim is rejected because the applicant does not describe the computer readable medium as being tangible medium. Computer readable mediums include both tangible mediums (storage mediums) and non-tangible mediums (carrier waves and transmission media). Appropriate correction is required.

To expedite a complete examination of the instant application the claims rejected under U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of application amending these claims to place them within the four categories of invention.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-20 are rejected under 35 U.S.C 103(a) as being unpatentable over **Hovell et al. (Hovell hereinafter)** (International Publication Number WO 02/073933) in view of **Ananda et al. (Ananda hereinafter)** (U.S. PG Pub No. 2004/0107287).

With respect to claim 1, **Hovell** teaches **an apparatus comprising:**

“a name resolving unit configured to perform name resolving” as means for assigning an alias to a target network device in the first network, the alias being compatible with the communication protocol of the second network (**Hovell** Page 2, Lines 12-14) (**Hovell** Page 5, Lines 18-31).

“a first connection unit configured to provide a first direct connection to a first network using a first network protocol” as providing communication between a network device in a first network and a network device in a second network, where the first network operates in accordance with a first communication protocol and the second

network operates in accordance with a second communication protocol (**Hovell** Page 2, Lines 8-11) (**Hovell** Figure 1).

“a second connection unit configured to provide a second direct connection to a second network using a second network protocol” as providing communication between a network device in a first network and a network device in a second network, where the first network operates in accordance with a first communication protocol and the second network operates in accordance with a second communication protocol (**Hovell** Page 2, Lines 8-11) (**Hovell** Figure 1).

“wherein the name resolving unit in the first network must forwards a name resolving request to a domain name service server in the second network” as (**Hovell** Figure 1). Examiner interprets the DNS 104 as name resolving unit in first network and DNS 106 as name resolving unit in the second network.

“an address translation unit configured to perform address translation between the first network and the second network” as means for translating said assigned alias to an address for the target network device, said translated address being compatible with the communication protocol of the first network (**Hovell** Page 2, Lines 15-17).

“wherein the name resolving unit and the address translation unit are configured to co-operate in order to translate addresses upon performing name resolving” as said assigned alias corresponds to an address of the second means, such that, when a network device in the second network sends one or more communication(s) using an address comprising the assigned alias, the or each

communication is routed to the second means, whereupon the second means translates the alias into the address of the target network device in the first network and sends the communication(s) into the first network (**Hovell** Page 2, Lines 19-24).

Hovell teaches the limitations of claim 1 as noted above but does not explicitly disclose “**wherein the name resolving unit in the first network must forwards a name resolving request to a domain name service server in the second network, the name resolving request is sent directly from the name resolving unit in the first network to the second network.**”

However, **Ananda** discloses, “**wherein the name resolving unit in the first network must forwards a name resolving request to a domain name service server in the second network, the name resolving request is sent directly from the name resolving unit in the first network to the second network**” as the DNS server 125, will necessarily have to be changed from IPv4 to dual-stack hosts that operate on both IPv4 and IPv6, to enable existing IPv4 or new IPv6 applications on the hosts and servers, to run without modification (**Ananda** Paragraphs 0063, 0071, 0079, 0080, 0083-0085, and 0130).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because **Ananda’s** teaching would have allowed **Hovell** to provide a transparent communication between IPv4 and IPv6 networks by using dual stack DNS.

Claims 10, 19 and 20 are essentially the same as claim 1 except claims 10 and 20 set forth the claimed invention as a method and a computer program and are rejected for the same reasons as applied hereinabove.

With respect to claim 2, **Hovell** teaches **“the apparatus according to claim 1, wherein the apparatus comprises a domain name service server”** as such processes include the DNS application level gateway (**Hovell** Page 5, Line 26).

Claim 11 is essentially the same as claim 2 except it sets forth the claimed invention as a method and is rejected for the same reasons as applied hereinabove.

With respect to claim 3, **Hovell** teaches **“the apparatus according to claim 1, wherein the address translation unit is configured to select a particular network address translating element to be used for a connection between a first host in the first network and a second host in the second network”** as the translator 101 then looks up 306 the mapping between assigned Ipv4 address and Ipv6 address to retrieve the Ipv6 address of host A, and make this 308 the destination address of the packet. For the packets to be routed from the translator 101 to host A, the translator 101 has to modify the source address of the packet, which is the Ipv4 address of node C, into Ipv6 format. This involves expanding 310 the Ipv4 address of host C with a prefix that is representative of the translator 101 (**Hovell** Page 6, Lines 16-22).

“wherein the address translation unit is configured to add network address translating element information to the resolved address” as when an Ipv4 packet arrives at the translator 101 a 96 bit prefix, which is indicative of the translator 101, is added to the source address of the packet (32 bits) to make an Ipv6 address (128 bits) (Hovell Page 6, Lines 25-27).

Claim 12 is essentially the same as claim 3 except it sets forth the claimed invention as a method and is rejected for the same reasons as applied hereinabove.

With respect to claim 4, Hovell teaches **“the apparatus according to claim 3, wherein the network address translating element information is an address prefix”** as an IPv4 source address 10.10.10.10 arriving at the translator 101 could be given the prefix 2001:618:1:2:: so that the source IPv4 host has the following address in the IPv6 world 2001:618:1:2::10.10.10.10. An IPv6 packet sent to this address would go to translator 101 because the prefix 2001:628:1:2:: routes to the translator 101 (Hovell Page 6, Lines 28-32).

Claim 13 is essentially the same as claim 4 except it sets forth the claimed invention as a method and is rejected for the same reasons as applied hereinabove.

With respect to claim 5, Hovell teaches **“the apparatus according to claim 3, wherein the address translation unit is configured to select a network address**

translating element based on information regarding the load on the network address translating element” as the selecting means is operable to monitor the device characteristics, so that selection of a device is based on current device performance. Monitored device characteristics include at least one of operational status of device, loading on device, and/or aliases available to the device (**Hovell** Page 3, Lines 8-11).

Claim 14 is essentially the same as claim 5 except it sets forth the claimed invention as a method and is rejected for the same reasons as applied hereinabove.

With respect to claim 6, **Hovell** teaches **“the apparatus according to claim 1, wherein the first protocol is internet protocol version 6, and the second protocol is internet protocol version 4”** as a device so identified thereafter deal with all subsequent communication between hosts in IPv6 and IPv4, and the subsequent communication is therefore independent of the controller operations (**Hovell** Page 7, Lines 26-27).

Claim 15 is essentially the same as claim 6 except it sets forth the claimed invention as a method and is rejected for the same reasons as applied hereinabove.

With respect to claim 7, **Hovell** teaches **“the apparatus according to claim 1, wherein the name resolving unit of the apparatus is configured to send a name**

resolve request to a name resolving element located in the second network” as means for assigning an alias to a target network device in the first network, the alias being compatible with the communication protocol of the second network (**Hovell** Page 2, Lines 12-14). Assigned alias corresponds to an address of the second means, such that, when a network device in the second network sends one or more communication(s) using an address comprising the assigned alias, the or each communication is routed to the second means, whereupon the second means translates the alias into the address of the target network device in the first network and sends the communication(s) into the first network (**Hovell** Page 2, Lines 19-24).

Claim 8 is essentially the same as claims 1, 3 and 5, which sets forth the claimed invention as a system and is rejected for the same reasons as applied hereinabove.

With respect to claim 9, **Hovell** teaches **“the system according to claim 8, wherein the load information is sent using a simple network management protocol”** as the controller 401 can derive the loading on a device 403a by issuing simple network management protocol (SNMP) messages to a Management Information Base (MIB) that is maintained on the router (**Hovell** Page 9, Lines 17-19).

Claims 16 & 17 are essentially the same as claim 8 & 9 except they set forth the claimed invention as a method and are rejected for the same reasons as applied hereinabove.

With respect to claim 18, **Hovell** teaches “**the method according to claim 10, wherein the processing a name resolve request processing comprises: forwarding a name resolve request from the first network directly to a network name resolving element in the second network; and receiving an address from the name resolving element in the second network**” as means for assigning an alias to a target network device in the first network, the alias being compatible with the communication protocol of the second network (**Hovell** Page 2, Lines 12-14). Assigned alias corresponds to an address of the second means, such that, when a network device in the second network sends one or more communication(s) using an address comprising the assigned alias, the or each communication is routed to the second means, whereupon the second means translates the alias into the address of the target network device in the first network and sends the communication(s) into the first network (**Hovell** Page 2, Lines 19-24).

Response to Arguments

5. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

In these arguments applicant relies on the amended claims and not the original ones.

Examiner has combined a new secondary reference Ananda et al which teaches dual stack DNS. Examiner interprets the dual stack DNS as enhanced DNS of the applicant.

Further, examiner could also interpret that it would have obvious to combine NAT-PT of Hovell in the DNS of IPv6 network of Hovell to provide the functionality of enhanced DNS server. In obviousness law, it is commonplace that combination of two things typically used together into a single thing is obvious unless the applicant can show secondary considerations rebutting the apparent obviousness. See, e.g., *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969); *Richardson-Vicks Inc. v. Upjohn Co.*, 122 F.3d 1476, 44 USPQ2d 1181 (Fed. Cir. 1997).

Claims must be given the broadest reasonable interpretation during examination and limitations appearing in the specification but not recited in the claim are not read into the claim (See M.P.E.P. 2111 [R-I]).

Contact Information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usmaan Saeed whose telephone number is (571)272-4046. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571)272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Usmaan Saeed
Patent Examiner
Art Unit: 2166

US
September 9, 2008

/Hosain T Alam/

Supervisory Patent Examiner, Art Unit 2166